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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/518,421

12/17/2004

Stanley George Bonney

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GLAXOSMITHKLINE

CORPORATE INTELLECTUAL PROPERTY, MAI B475

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EXAMINER

SMITH, RICHARD A

ART UNIT

PAPER NUMBER

2859

MAIL DATE

DELIVERY MODE

10/02/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/518,421

Applicant(s)

BONNEY ET AL.

Examiner

R. Alexander Smith

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 December 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-62 is/are pending in the application.
- 4a) Of the above claim(s) 15-22, 24-28 and 30-62 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 9-13 is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☒ Claim(s) 14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 20041217.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-14, drawn to an indicator structure, classified in class 116.

Group II, claim(s) 15-22, 24-28, and 30-34, drawn to a canister casing, classified in class 222.

Group III, claim(s) 35-62, drawn to a drug dispensing apparatus and method, classified in class 128.

2. The inventions listed as Groups I, II, and III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons:

Group I is drawn to an indicator structure that can be used in applications not involving the specifics of Groups II or III. The axle provided by a spring adapted to bias a rotatable element and the rack and pinion are considered a "special technical feature."

Art Unit: 2859

Group II is drawn to canister casing that can be used in applications not involving the specifics of Groups I or III. The casing adapted to be attached over a valve stem considered a "special technical feature."

Group III is drawn to a drug product and method of patient compliance that can be used in applications not involving the specifics of Groups I or II. The drug product is considered a "special technical feature."

3. During a telephone conversation with Examiner Lorie Ann Morgan on 9/17/2007 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-22, 24-28, and 30-62 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

### ***Claim Objections***

Claims 5-8 and 14 are objected to because of the following informalities:

Claim 5: "at least two rotatable elements" does not properly refer to its antecedent introduced in claim 1.

Claim 6: "optionally being provided by the spring" makes the claim confusing because it is not clear if this limitation is being claimed.

Art Unit: 2859

Claim 7: "the or each rotatable element on the axle and the other element" is grammatically and idiomatically confusing and unclear.

Claim 14: "at least two rotatable indicator wheels " in line 2 does not properly refer to its antecedent introduced in claim 9.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2 and 4-8 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 57-103585 to Shibazaki et al.

Shibazaki et al. discloses an axle (26 or 27) of a rotatable element (29-32 or 33-35 respectively) of an actuation indicator (figure 1), wherein the axle is provided by a spring (see below) that is adapted in use to bias the rotatable element towards another element (33-35 or 29-32 respectively) of the actuation indicator with which the rotatable element is engaged,

the rotatable element is a pinion (33-35),

wherein the rotatable element is an indicator wheel (29-32) for indicating actuation of a device with which the indicator is associated,

wherein there are at least two rotatable elements on the same axle (as shown),

wherein the other element (33-35) is a rotatable element mounted on a second axle (27), the second axle optionally being provided by the spring (25 as shown), wherein the spring comprises the second axle and a biasing section (basement part 28) connecting the two axles to bias them together, and

an assembly comprising the axle of claim 1, the or each rotatable element on the axle and the other element (figure 1).

With respect to "the axle is provided by a spring": Shibazaki et al. discloses that the axle is either a bent filament or of polyacetal resin (which can have spring-elastic qualities), and provides slots 6/7 and 8/9 in which the parts 26 and 27 are respectively mounted by slipping them over the unmarked tab portions (see figure 2) which would require a degree of resiliency, i.e., springiness, to return to a useable condition wherein the gears mesh once mounted in the slots and/or to maintain the pinions in contact with the wheels. Therefore, in a broad sense, this resiliency meets the limitation of the axle being provided by a spring as claimed.

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shibazaki et al. in US 6,474,331 to view of US 6,067,927 to Johnson et al.

Shibazaki et al. teaches all that is claimed as discussed in the above rejections of claims 1, 2 and 4-8 except for wherein the other element with which the pinion engages is a rack.

Johnson et al. discloses a rotary cylindrical display members and teaches that a linear movement can be converted by using a rack in combination with a spur gear or pinion attached to the cylindrical members. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the counter, taught by Shibazaki et al., by utilizing a rack as the other element, as suggested by Johnson et al., in order to convert a linear movement to the rotatable elements of the counter and to increase the uses and versatility for the counter.

*Allowable Subject Matter*

8. Claims 9-13 are allowable.
9. Claim 14 would be allowable if rewritten to overcome the claim objections set forth in this Office Action and to include all of the limitations of the base claim and any intervening claims.
10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

*Conclusion*

The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The prior art cited in PTO-892 and not mentioned above disclose related actuation indications, or related components and features.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. Alexander Smith whose telephone number is 571-272-2251. The examiner can normally be reached on Monday through Friday from 9:30-6:00.



Art Unit: 2859

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F. Gutierrez can be reached on 571-272-2245. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'R. Alexander Smith', with a long horizontal stroke extending to the right.

R. Alexander Smith  
Primary Examiner  
Technology Center 2800

RAS  
September 26, 2007